Remarks

Applicant respectfully requests reconsideration of this application as amended. Claims 1-4, 7-9 and 12-21 have been amended. No claims have been cancelled. Therefore, claims 1-26 are presented for examination.

Applicant acknowledges that claims 2-4 would be patentable if amended to include the features of the base claim.

Claims 1, 5, 6, and 7 stand rejected under 35 U.S.C. §102(e) as being anticipated by Fischer et al. (U.S. Patent No.6,732,311). In addition, claims 8-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fischer. Applicant submits that the rejections with respect to claims 1, 5, 6, and 7-11 have been obviated by the amendment of claims 1 and 7. For instance, claim 1 has been amended to include the features of claim 2, which has been asserted by the Office Action to be patentable if combined with base claim 1. Further, claim 7 has been amended to include similar patentable features as included in claim 1. Because claims 2-6 and 8-11 depend from claims 1 and 7, respectively, and include additional features, claims 2-6 and 8-11 are also patentable over Fischer.

Moreover claims 12-21 are also patentable over Fischer. Fischer discloses an integrated circuit having a debugger, memory, and core so that the debugger may directly access points internal to the memory and the core. The debugger includes an instruction register for storing one or more debugging instructions, a status vector register for storing one or more status events, a comparator for comparing one or more status events with internal integrated circuit signals to generate an indicator at its output in the event of a match, a finite state machine (FSM), and a multiplexer controlled by the FSM for inserting debugging instructions from the instruction register into the integrated circuit for use by a

core. A method for debugging the integrated circuit with the debugger includes specifying an event internal to an integrated circuit, detecting the event by internally monitoring the integrated circuit for the occurrence of the event, and performing debugging instructions upon the occurrence of the event. See Fischer at col. 3, ll. 29-55

Claims 12 and 17 each recite receiving test setup information at an integrated circuit via an integrated test port and initiating a test upon detecting that a data request passing through a bus controller matches a data request at a detection library. Applicant submits that nowhere in Fischer is there disclosed a processes of initiating a test upon detecting that a data request passing through a bus controller matches a data request at a detection library. Therefore, claims 12 and 17 are patentable over Fischer.

Since claims 13-16 and 18-21 depend from claims 12 and 17, respectively, and include additional features, claims 13-16 and 18-21 are also patentable over Fischer.

Claims 22-26 stand rejected under 5 U.S.C. §103(a) as being unpatentable over Fischer in view of Miner et al. (U.S. Patent No. 2002/0083387). Applicant submits that Miner may not be considered as prior art precluding patentability of the present application.

Section 103(c) states that:

> *Subject matter developed by another person, which qualifies as prior art only under one or more of the subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.*

Miner is considered prior art under 35 U.S.C. §102(e) because it was filed prior to the filing of the present application, but was published after the filing of the present application

(effective filing date: 01-02-2002). Additionally, at the time of conception of the present application, the Miner reference and the application were both subject to an obligation of assignment to Intel Corporation. Therefore, due to the §102(e) status, and in light of §103(c), Miner cannot be used as a reference to preclude the patentability of claims 22-26 under 35 U.S.C §103. Applicant respectfully requests the withdrawal of the rejection of the claims under 35 U.S.C. §103 in view of Fischer and Miner since Fischer alone does not preclude the patentability of claims 22-26.

Applicant submits that the rejections have been overcome and that the claims are in condition for allowance. Accordingly, applicant respectfully requests the rejections be withdrawn and the claims be allowed.

The Examiner is requested to call the undersigned at (303) 740-1980 if there remains any issue with allowance of the case.

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: <u>November 19, 2004</u>

Mark L. Watson
Reg. No. 46,322

12400 Wilshire Boulevard
7th Floor
Los Angeles, California 90025-1026
(303) 740-1980